

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED *Ex parte* JOSEPH P. KRONZER and JAMES F. DYRUD

FEB 11 1999

Appeal No. 98-0809
Application No. 08/661,834¹

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before COHEN, MEISTER and ABRAMS, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Joseph P. Kronzer and James F. Dyrud (the appellants) appeal from the final rejection of claims 25-34, the only claims remaining in the application.

We AFFIRM.

¹ Application for patent filed June 11, 1996. According to appellants, this application is a continuation of Application No. 08/154,989 filed November 18, 1993, now abandoned; which is a division of Application No. 07/632,964 filed December 20, 1990, now U.S. Patent No. 5,307,796 issued May 3, 1994.

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The appellants' invention pertains to a fibrous filtration face mask. Independent claim 32 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Thiebault	4,363,682	Dec. 14, 1982
Dyrud et al. (Dyrud)	4,807,619	Feb. 28, 1989

Claims 25-34 stand rejected under 35 U.S.C. § 112, first and second paragraphs.²

Claims 25-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dyrud in view of Thiebault.

The rejections are explained on pages 4-7 of the answer. The arguments of the appellants and examiner in support of their respective positions are found on pages 3 and 4 of the brief, pages 1-6 of the reply brief and pages 8-10 of the answer.

² These rejections were set forth in the final rejection dated September 12, 1995 (Paper No. 10). While the new final rejection dated October 2, 1996 (Paper No. 17) failed to include these rejections, the answer nevertheless lists the rejections as being applicable to the claims on appeal. Accordingly, we conclude that the examiner's failure to include these rejections in Paper No. 17 was an inadvertent omission. The appellants are not prejudiced by this interpretation since they have argued the rejections in the reply brief.

OPINION

At the outset, we note that page 3 of the brief states that the rejected claims stand or fall together. Accordingly, claims 25-34 will stand or fall with representative claim 32. 37 CFR § 1.192(c)(7).

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and reply brief, and by the examiner in the answer. As a consequence of this review, we will sustain the rejection of claims 25-34 under 35 U.S.C. § 103. We will not, however, sustain the rejections of claims 25-34 under 35 U.S.C. § 112, first and second paragraphs.

Considering first the rejections of claims 25-34 under 35 U.S.C. § 112, first and second paragraphs, it is the examiner's position that

the claimed invention is not described in such full clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no evidence in the record that this term (i.e. "surface fuzz value") is an accepted term or test by those skilled in the art. It is noted that in applicant's determination of this value that applicant makes two tests and averages the results of these tests

to arrive at a value. Therefore, when two testers who obviously are trying to be as accurate as possible can likely arrive at different results, there is no assurance that those skilled in the art would be able to conclude with a reasonable degree of certainty whether or not this language (i.e. "surface fuzz value" was infringed.

Accordingly, this terminology is not taught in such a way as to enable those in the art to reliably determine surface fuzz values and also fails to point out and distinctly claim as required by 35 USC 112 second paragraph. [Answer, page 7.]

We will not support the examiner's position. The test regarding enablement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) and the legal standard for indefiniteness is whether a claim reasonably apprises those of skill in the art of its scope (*In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994)). Here, we do not believe that it can seriously be contended that one of ordinary skill in this art would not (1) know how to make and use the invention without undue experimentation and (2) be reasonably apprised of the scope of the claims.³ Pages 16-18 of the specification clearly

³ With respect to this latter determination it should be noted that the court stated in *In re Moore*, 439 F.2d 1232, 1235,
(continued...)

describe what "fuzz values" are and how they are obtained. More specifically, (1) page 16 of the specification clearly describes in detail how the abrasion test is to be performed, (2) page 17 provides a scale for determining the fuzz value from the results of the abrasion tests and (3) page 18 fully describes how the scale is to be used for determining the fuzz value in light of the abrasion test results. While the examiner opines that two testers would "likely" get different results when performing the abrasion tests, no reasons have been provided as to why this might be the case. In any event, the fact that slightly different results may be obtained between successive tests does not mean that one of ordinary skill in the art would not be **reasonably** apprised of the scope of a fuzz value of "at least 7.5" as set forth in independent claims 25 and 32. Whether the

³(...continued)
169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of **the particular application disclosure** as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis added; footnote omitted.]

term "fuzz value" or the abrasion test are "accepted by those skilled in the art" is irrelevant inasmuch as the specification clearly defines what "fuzz value" is and describes in great detail how the abrasion test is to be performed. Accordingly, we will not sustain the rejections of claims 25-34 under 35 U.S.C. § 112, first and second paragraphs.

Turning to the rejection of claims 25-34 under 35 U.S.C. § 103 as being unpatentable over Dyrud in view of Thiebault, the appellants argue that there is (1) no teaching or suggestion in either of these references of "how to produce a molded nonwoven face mask that maintains low degrees of surface fuzz" (brief, page 4) and (2) there is no suggestion to combine the teachings of Dyrud and Thiebault. However, even if we were to agree with the appellants that there is no suggestion to combine the teachings of Dyrud and Thiebault in the manner proposed by the examiner, we are of the opinion that there is a sound basis to conclude that representative claim 32 does not define over Dyrud taken alone.

More specifically, the appellants depict in Fig. 6 a graphical representation which illustrates a "curve" 37 formed by the plotting of surface fuzz values for "hot molded shells" (see

page 15, lines 10 and 11)⁴ vis-à-vis the percentage of bicomponent fiber content. This graph appears to clearly illustrate that, when the percentage of bicomponent fiber approaches or reaches 100%, the surface fuzz value is 7.5 or greater. Since Dyrud (1) states that his shaping layers are molded as taught in U.S. Patent No. 4,536,440 (which page 2 of the specification states involves heated molds), (2) indicates that the bicomponent fiber content may be 100% (see column 4, lines 29-37)⁵ and (3) appears to plainly illustrate in Fig. 6 that when the percentage of bicomponent fiber approaches or reaches 100% the surface fuzz value is 7.5 or greater, there is a sound basis to conclude that Dyrud's disclosed fibrous filtration face mask **inherently** has a surface fuzz value of not less than 7.5. Accordingly, representative claim 32 lacks novelty.⁶ While

⁴ Page 2 of the specification has previously referenced U.S. Patents 4,807,619 and 4,536,440 as showing shaping layers produced in "heated molds."

⁵ The recitation in representative claim 32 of "at least 40 weight percent thermally bonding fibers" does not preclude the bicomponent fibers themselves from satisfying this limitation.

⁶ Where, as here, there is a sound basis to believe that the critical function for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art device, it is incumbent upon an appellant to prove that the prior art device does not in fact possess the characteristics relied on. **See, e.g., In re Schreiber**, 128 F.3d 1473, 1478, 44 (continued...)

we appreciate the fact that the examiner described the rejection in terms of obviousness rather than lack of novelty, we note that lack of novelty is the epitome of obviousness. **See In re Fracalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

The appellants have correctly noted that there is no teaching or suggestion in Dyrud that a low degree of surface fuzz (e.g., 7.5) is present. We must point out, however, that a prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, **either** explicitly **or inherently**. **Schreiber**, 128 F.3d at 1477, 44 USPQ2d at 1431 and **Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). See also **Spada**, 911 F.2d at 708, 15 USPQ2d at 1657: "The discovery of a new property or use of a previously known composition, even when

⁶(...continued)
USPQ2d 1429, 1432 (Fed. Cir. 1997); **In re Spada**, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) and **In re Best**, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433 (CCPA 1977).

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that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."

In view of the foregoing, we will sustain the rejection of claims 25-34 under 35 U.S.C. § 103.

In summary:


The rejections of claims 25-34 under 35 U.S.C. § 112, first and second paragraphs, are reversed.

The rejection of claims 25-34 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



IRWIN CHARLES COHEN
Administrative Patent Judge

James M. Meister
JAMES M. MEISTER
Administrative Patent Judge

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